

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit: 1612
 Examiner: P. Morris
 Applicant(s): AG Romero
 Serial Number: 09/313,534
 Filed: May 13, 1999
 For: Heterocyclic Amines Having Central Nervous System Activity



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Commissioner of Patents and Trademarks
 Washington, DC 20231

REISSUE DECLARATION (37 CFR §1.63, 1.175 AND 1.178)
AND POWER OF ATTORNEY

As a below-named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name, and

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled **Heterocyclic Amines Having Central Nervous System Activity**, Docket No. **4830.P RE**, the specification of which

- ☐ is attached hereto.
- ☒ was filed on May 13, 1999 as Application Serial No. 09/313,534.
- ☐ was filed on as PCT International Application No. and was amended under PCT Article 19 on , if applicable.

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with 37 CFR §1.56(a).

I hereby claim the benefit under 35 USC §119(e) of any United States provisional application(s) listed below:

Application	Filing Date
<u>Serial No.</u>	<u>(Day/Month/Year)</u>

I hereby claim foreign priority benefits under 35 USC §119(a)-(d), or §365(b), of any foreign application(s) for patent or inventor's certificate or §365(a) of any PCT International Application(s) designating at least one country other than the United States of America listed below and have also identified below any foreign application for patent or inventor's certificate or any PCT International Application(s) designating at least one country other than the United States of America filed by me on the same subject matter having a filing date before that of the application on which priority is claimed:

<u>Application</u> <u>Serial No.</u>	<u>Country</u>	<u>Filing Date</u> <u>(Day/Month/Year)</u>	<u>Priority Claimed</u> <u>(Yes/No)</u>
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I hereby claim the benefit under 35 USC §120, of any United States application(s) or PCT International Application(s) designating the United States of America that is/are listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application(s) in the manner provided by the first paragraph of 35 USC §112, I acknowledge the duty to disclose material information as defined in 37 CFR §1.56(a), which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

<u>Application</u> <u>Serial No.</u>	<u>Filing Date</u>	<u>Status (Patented, Pending, Abandoned)</u>
08/097608	July 27, 1993	Abandon
PCT/US94/06648	June 17, 1994	Abandon
08/592328	January 23, 1996	US Patent 5,652,245

In compliance with the relevant sections of 37 C.F.R. §1.175(a), the applicant states:

(1) The applicant believes the original patent to be partly inoperative because inadvertently the four important intermediate compounds were not claimed.

(2) The particular defect is that the four compounds of Examples 5(5), 5(6), 5(7) and 5(8) were not claimed. These compounds are the subject matter of claims 9-12 of the Reissue application.

(3) The applicant believes US patent 5,652,245 to be partially inoperative because it claims less than the applicant had the right to claim. The applicant had the right to claim the four compounds of Examples 5(5), 5(6), 5(7) and 5(8) because by the specification the applicant had complied with 35 U.S.C. §112 and all other relevant statutory provisions. A compound within the scope of claim 1 is in human clinical trials and the four compounds of Examples 5(5), 5(6), 5(7) and 5(8) could be important intermediates in processes to produce the compound in clinical trials.

(4) Because the four compounds of Examples 5(5), 5(6), 5(7) and 5(8) were fully disclosed within the meaning of 35 U.S.C. §112 in the patent application which issued as US Patent 5,652,245, the applicant had more than adequate support in the parent national phase patent application to have claimed these four compounds.

(5) Unfortunately both the applicant and the applicant's present attorney has absolutely no idea of how the error occurred (why the four compounds were not claimed). The attorney who drafted and prosecuted the patent application which matured into US 5,652,245 is not longer employed by the assignee and is employed by a competitor.

I believe the error was found by the undersigned when he was drafting a patent application claiming the commercial process to prepare the compound in human clinical trials.

(6) The error arose without any deceptive intention.

(7) The applicant acknowledges his duty to disclose to the Patent Office all information known to the applicant to be material to patentability as defined in 37 C.F.R. §1.56

In compliance with the relevant sections of 37 C.F.R. § 1.178, the applicants hereby offer to surrender the original US Patent 5,652,245.

I hereby appoint Carl W. Battle (Registration No. 30,731); James D. Darnley, Jr. (Registration No. 33,673); Ellen K. Park (Registration No. 34,055); Bruce A. Pokras (Registration No. 32,748); Edward F. Rehberg (Registration No. 34,703); Andrew M. Solomon (Registration No. 32,175); Bruce Stein (Registration No. 27,231); Thomas A. Wootton (Registration No. 35,004); and Lucy X. Yang (Registration No. 40,259); all registered to practice before the Patent and Trademark Office as my attorneys or agents with full power of substitution and revocation to prosecute this application and all divisions and continuations thereof and to transact all business in the Patent and Trademark Office connected therewith and request that all correspondence and telephone communications be directed to the following person at the mailing address and telephone number hereafter given:

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Inventor's Signature <u>Arthur Glenn Romero</u>	Date <u>7 April 2000</u>
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